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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,566	01/11/2001	Allan Stuart Algazi	1071	9680

23720 7590 02/18/2004

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,566

Applicant(s)

ALGAZI, ALLAN STUART

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 4-9, 16-21 and 24-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10-15, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, drawn to a method of obtaining a package, classified in class 705, subclass 1.
 - II. Claims 24-31, drawn to a method of establishing service for delivery, classified in class 705, subclass 1.
 - III. Claims 32-41, drawn to a method of returning a package, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions all use the biometric information encoded in a two-dimensional barcode, but each invention has a different function. Invention I has the function of obtaining a package, Invention II has the function of delivering a package, and Invention III has the function of returning a package.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

a. Group 1:

i. Claims 6, 18, 29, 35 are drawn to one specific species of the biometric information.

ii. Claims 7, 19, 31, and 36 are drawn to another independent and distinct species of the biometric information.

iii. Claims 8, 20, 28, and 37 are drawn to another independent and distinct species of the biometric information.

iv. Claims 9, 21, 27, and 38 are drawn to another independent and distinct species of the biometric information.

v. Claims 10, 11, 22, 30, and 39 are drawn to another independent and distinct species of the biometric information.

b. Group 2:

i. Claims 3 and 15 are drawn to one specific species of the electronic notification step.

ii. Claims 4 and 16 are drawn to another distinct and independent species of the electronic notification step.

iii. Claims 5 and 17 are drawn to another distinct and independent species of the electronic notification step.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species in Group 1 and a single disclosed species in Group 2 for prosecution on the merits to which the claims shall

be restricted if no generic claim is finally held to be allowable. Currently, 1-3, 12-14, 23-28, 29, 31-34, 40 and 41 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mark Sincell on 2/4/04 a provisional election was made without traverse to prosecute the invention of the method of obtaining a package, with the biometric information being the signature, and the notifying step via a cell phone, claims 1-3, 10-15, 22 and 23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-9, 16-21 and 24-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 10-15 and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1 and 13 recites the limitations "the user's previously provided biometric information" and "the user's current biometric information". There is insufficient antecedent basis for these limitations in the claim. The claim never states the collection of any of this information, and never states if the information is stored anywhere in a system or device, therefore it is unclear to the examiner how this information is obtained or conveyed in order to compare the info for verification purposes.

6. With respect to Claim 1: the phrase "if the user's current biometric information is equivalent to the user's current biometric information," is indefinite. The claim the current biometric information to itself, therefore it is unclear to the examiner what the purpose of this step is.

7. With respect to Claims 2 and 13: the phrase "presenting the package for visual inspection by the user prior to providing the package to the user" is indefinite. It is unclear to the examiner how the package can be visually inspected without first providing the package to the user.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 10, 11, 13, 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recktenwald et al. (6,439,345) in view of Smithies et al. (5,647,017).

10. With respect to Claims 1, 10, 11, 13 and 22: Recktenwald discloses the use of an item pick-up system which includes a notifying paging system (116) which notifies a user electronically that the item is ready for pick-up (column 5, lines 19-31 and Claim 13), a scanner that scans a barcode on a printed receipt to decode and display item being picked up as well as the customer order information (Figure 5), once the order is selected it is transmitted to the stock room where an attendant fulfills the order and provides it to the customer (see abstract). Recktenwald however fails to disclose the customer is verified using previously and currently biometric information. Smithies discloses the use of a method and system for the verification of biometric information such as handwritten signatures, in the use of obtaining packages (See abstract, column 1, lines 53-59, column 5, lines 28-41, and column 6, lines 27-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the verification system using signatures, as disclosed by Smithies, to identify a customer in the item pick-up system of Recktenwald, in order to provide secure evidence as to the real identity of a user, and to assist in the detection and prevention of forgery and fraud (see Smithies,

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columns 1 and 5). The examiner considers the stored signature data to be a part of the customer information which is encoded into the barcode of Recktenwald.

11. With respect to Claims 2 and 14: Recktenwald discloses the system presenting a description as well as a visual picture of the item to be picked up before it is provided to the customer (See Figure 12).

12. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recktenwald and Smithies as applied to claims 1 and 13 above, and further in view of Stephens et al. (6,323,782).

13. Recktenwald discloses the use of notifying electronically when an item is ready for pick-up using a paging system or using RF transmission, but fails to disclose electronically notifying the user via cell phone. Stephens discloses the use of a delivery system where a receiver or customer is notified via RF transmission or via a cell phone, when an item is delivered to the location and ready for pick-up (column 9, lines 39-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the notification of an item being ready for pick-up as disclosed by Stephens, in the system of Recktenwald and Smithies, in order to provide the customer information that is remotely passed without the use or dependency on lines or cables, and therefore allowing the information to be sent to remote locations (See Stephens columns 9-11).

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14. Claims 12 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recktenwald and Smithies as applied to claims 1 and 13 above, and further in view of Keagy et al. (6,069,969).

15. Recktenwald and Smithies, as disclosed above discloses the use of a barcode, but does not specifically disclose the use of the barcode using PDF 417 technology. Keagy discloses the use of a barcode that is encrypted with biometric information for use in verification purposes, and utilizes PDF 417 barcodes (column 10, lines 57-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the barcode of Recktenwald be the 2-D barcode using PDF 417 symbols, as disclosed by Keagy, in order to provide an template that can encode a users biometric information and to allow for a secure encryption of the data. (see Keagy, column 10).

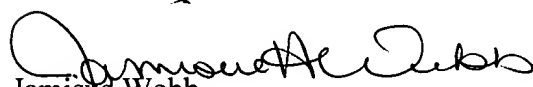
Conclusion

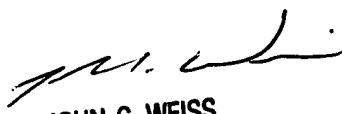
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sansone et al. (6,028,517) discloses the use of a delivery system where a status is indicated whether a deposit of items have been placed in a recepticle, Bennett (6,114,959) discloses the use of an automated mail alert system, Huxter (US 2002/0107820) discloses the use of a notification system when a package is ready where the notification is transmitted via cell phone, Reichl et al, discloses the use of a method of controlling the delivery and pick up of goods, Black (WO 03/036861) discloses the use of an identity authentication system using a barcode and signature, IBM Technical Disclosure Bulletin (NN960175) discloses the use of a signature recognition system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamisue Webb


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